

Appl. No.: 10/087,465
Reply to Office Action of: 07/28/2005

20, 22-24, 30-31, 37 and 42 was rejected under 35 U.S.C. §103(a) as being unpatentable over Nakai et al. (US 2002/0033779 A1) in view of Chew (US 2005/0138448 A1). Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Nakai et al. (US 2002/0033779 A1) in view of Chew (US 2005/0138448 A1) and Horvitz (US 2004/0236719 A1). Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over Nakai et al. (US 2002/0033779 A1) in view of Chew (US 2005/0138448 A1) and Schuster et al. (US 6,584,490). The examiner is requested to reconsider these rejections.

In regard to claim 1, Chew relates to prioritization used in terminating an application program; not prioritizing user stored files. It was not obvious to combine a prioritization process used for termination of an application program as described in Chew with Misawa's digital camera. Merely because references can be combined does not mean that it is obvious to combine them. Misawa discloses a digital camera. There is no disclosure or suggestion of multiple application programs. Thus, there is no disclosure of terminating an application program in the camera having multiple application programs requiring prioritization of termination. Because there is no disclosure of terminating an application program in the camera (because, among other things, there is no disclosure or suggestion of multiple application programs), there is no suggestion of combining the teachings of Chew with the digital camera of Misawa et al. Even if, for the sake of argument, it was obvious to combine Chew with Misawa et al., this still would not produce applicants' claimed invention. In particular, claim 1 claims:

Appl. No.: 10/087,465
Reply to Office Action of: 07/28/2005

"a system for prioritizing the user stored files in the memory relative to one another, the system comprising means for prioritizing the user stored files relative to each other based upon a priority value established for the files by a combination of at least two of the different prioritization parameters."

There is no disclosure or suggestion of using the prioritization used in terminating an application program of Chew for prioritizing user stored files as called for in claim 1. Thus, even if it was obvious to combine the teachings of Chew with Misawa et al., this still would not produce applicants' claimed invention. As described in Chew, the process of calculating a priority value includes adding values of parameters associated with a particular application program. Five parameters are shown in Table 1 including application program average launch time, application program memory usage, application program application class, application program frequency of usage, and application program amount of data stored. These are all application program related parameters; not user stored files parameters. Chew only appears to suggest prioritizing terminating application programs in the digital camera of Mizawa (if Mizawa had multiple application programs - which it does not disclosed or suggested). However, there is no disclosure or suggest of prioritizing user stored files in Chew or applying the method of Chew to user stored files; especially because all the parameters described in Chew in Table 1 relate to application program parameters (not user stored file parameters). The features of claim 1 only become obvious

Appl. No.: 10/087,465
Reply to Office Action of: 07/28/2005

after reading applicants' patent application. Therefore, the cited art does not disclose or suggest the invention as claimed in claim 1.

In regard to the examiner's attempted combination of Nakai et al. in view of Chew relating to claim 1, again Chew merely discloses prioritization used in terminating an application program; not prioritizing user stored files. Nakai et al. discloses a priority appended to data types (paragraphs 0149-0150 and Table 1). A combination of Chew with Nakai et al. merely appears to suggest using Chew to prioritize terminating an application program in the electronic information distribution system of Nakai et al.; not prioritizing user stored files. There appears to be no suggestion to use the teachings of Chew to prioritize user stored files. Claim 1, on the other hand, claims means for prioritizing the user stored files relative to each other based upon a priority value established for the files by a combination of at least two of the different prioritization parameters. This is not suggested in the cited art.

In regard to claim 23, it claims a method including prioritizing the user stored files relative to each other based upon a priority value established for each of the files by a combination of at least two of the prioritization parameters associated with each of the files. Again, Chew relates to prioritization used in terminating an application program; not prioritizing user stored files. It was not obvious to combine a prioritization process used for termination of an application program as described in Chew with Misawa's digital camera. In Chew the parameters for

Appl. No.: 10/087,465
Reply to Office Action of: 07/28/2005

priority are application program average launch time, application program memory usage, application program application class, application program frequency of usage, and application program amount of data stored. These are not prioritization parameters used in user stored files, such as digital camera photograph files stored in Misawa. There is no disclosure or suggestion of application programs in Misawa's digital camera. Thus, there is no disclosure of terminating an application program in the camera. Because there is no disclosure of terminating an application program in the camera, there is no disclosure of combining the teachings of Chew with the digital camera of Misawa et al. Even if, for the sake of argument, it was obvious to combine Chew with Misawa et al., this still would not produce applicants' claimed invention. In particular, there is no disclosure of means for prioritizing the user stored files relative to each other based upon a priority value established for the files by a combination of at least two of the different prioritization parameters. A combination of Misawa et al. and Chew would merely suggest prioritizing termination of an application program in a digital camera; not prioritizing user stored files. Therefore, the cited art does not disclose or suggest the features recited in claim 23. The features of claim 23 only become obvious after reading applicants' patent application. Claim 23 is patentable and should be allowed.

In regard to the examiner's attempted combination of Nakai et al. in view of Chew relating to claim 23, again Chew merely discloses prioritization used in terminating an application program; not prioritizing user stored files. Nakai et al.

Appl. No.: 10/087,465
Reply to Office Action of: 07/28/2005

discloses a priority appended to data types (paragraphs 0149-0150 and Table 1). A combination of Chew with Nakai et al. merely appears to suggest using Chew to prioritize terminating an application program in the electronic information distribution system of Nakai et al.; not prioritizing user stored files. There appears to be no suggestion to use the teachings of Chew to prioritize user stored files. Claim 23, on the other hand, claims prioritizing the user stored files relative to each other based upon a priority value established for each of the files by a combination of at least two of the prioritization parameters associated with each of the files. This is not suggested in the cited art.

Claim 35 claims "a system for prioritizing the user stored files in the memory relative to one another, the system comprising means for prioritizing the user stored files relative to each other based upon both the second backup parameter and at least one of the first prioritization parameters for each file." Hayduk and Nakai et al. do not "anticipate" claim 35. The examiner has apparently misunderstood Hayduk. In Hayduk "138" are applications; not a second backup parameter as the examiner has stated. "134" are priorities assigned to applications; not user stored files as the examiner has stated. Also, contrary to the examiner's statements, "132" are not user stored files. "132" are service preferences. As noted in paragraph 0015, "if a match 139 arises because it is determined that one or more of the preferences 132 and one or more of the received list files 136 are related (as determined by the comparator module 137 or the user of the mobile element 102), an application APP22

Appl. No.: 10/087,465
Reply to Office Action of: 07/28/2005

associated with the matching preference or list file L2, which may be identical to the file F2, for example, can be broadcast and downloaded to the mobile element 102 by the broadcaster 104." The disclosure in Hayduk does not "anticipate" the features recited in claim 35. Hayduk does not disclose or suggest a system for prioritizing user stored files comprising means for prioritizing the user stored files relative to each other based upon both the second backup parameter and at least one of the first prioritization parameters for each file.

The examiner appears to have misunderstood the teachings of Nakai et al. Nakai et al. discloses use of a single priority onto data types (see table 1). Nakai does not disclose means for prioritizing user stored files relative to each other based upon both a second backup parameter and at least one first prioritization parameters for each file. Contrary to what the examiner has stated, "scrapbook information" does not contain a second backup parameter. A careful reading of Nakai et al. indicates that saved information is merely saved as filed information or scrapbook information (see paragraphs 0153-0162). Nakai et al. does not disclose or suggest the features as recited in claim 35. In Nakai et al., there is only one prioritization for the filed information or the scrapbook information; the priorities shown in table 1. There is no disclosure or suggestion of using the priorities shown in table 1 as a first and a second prioritization parameter as recited in claim 35. Nakai et al. does not "anticipate" claim 35.

Claim 37 claims a prioritization system for prioritizing user stored files. The prioritization system is adapted to

Appl. No.: 10/087,465
Reply to Office Action of: 07/28/2005

prioritize the user stored files based upon a priority value established for the files by a combination of at least two of the different prioritization parameters. As the examiner correctly notes, Nakai et al. does not disclose a priority value established by a combination of at least two different prioritization parameters. As noted above, Chew merely discloses prioritization used in terminating an application program; not prioritizing user stored files. Nakai et al. discloses a priority appended to data types (paragraphs 0149-0150 and Table 1). A combination of Chew with Nakai et al. merely appears to suggest using Chew to prioritize terminating an application program in the electronic information distribution system of Nakai et al.; not prioritizing user stored files. There appears to be no suggestion to use the teachings of Chew to prioritize user stored files of Nakai et al.; which are merely prioritized by data type as specified in table 1. Chew does not suggest changing prioritization of data types different from the prioritization method described in Nakai et al. (primarily because Chew relates to prioritizing termination of application programs; not prioritization of user stored files). The features of claim 35 are not disclosed or suggested in the art of record. Therefore, claim 35 is patentable and should be allowed.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issue remain,

SEP. 15. 2005 11:28AM

HARRINGTON & SMITH

NO. 095 P. 9

Appl No.: 10/087,465
Reply to Office Action of: 07/28/2005

the examiner is invited to call applicants' attorney at the telephone number indicated below.

Respectfully submitted,

Mark F. Harrington
Mark F. Harrington (Reg. No. 31,686)

9/15/05

Date

Customer No.: 29683
Harrington & Smith, LLP
4 Research Drive
Shelton, CT 06484-6212
203-925-9400

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

9/15/05
Date

Ana Okrentowich
Name of Person Making Deposit